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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,832	09/23/2003	Larry A. Christensen	P06486US1	4988
34082	7590	02/02/2005	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			GREEN, BRIAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/668,832

Applicant(s)

CHRISTENSEN, LARRY A.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledman et al. (U.S. Patent No. 4,194,629) in view of Kough (U.S. Patent No. 5,568,695).

Ledman et al. shows in figures 1-2 a package (11,12) that includes a note (15) having indicia thereon. Ledman et al. does not specifically state whether the note is placed on the package and the specific message placed on the note defined in claims 1 and 5. Kough shows in figure 10 the idea of placing a note (60) on a package (44). In view of the teachings of Kough it would have been obvious to one in the art to modify Ledman et al. by placing the note directly on the package since this would make it clear that the note belongs with the package, would help to prevent the note and package from being separated, and would allow the message on the note to be clearly seen. Ledman et al. does not disclose the specific message (request that the package remain unopened) defined by the applicant in claims 1 and 5. It would have been an obvious to one in the art to modify Ledman et al. by varying the message on the note since it is considered obvious to place any message on the note as desired, i.e. the particular indicia placed onto the note has been considered but it is not sufficient to distinguish the invention from the prior art (Ledman et al. in view of Kough) in terms of patentability. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art, see *In re Gulack*, 703

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F.2d 1381, 217 USPQ 401 (Fed. Cit. 1983). In the applicant's case, there is no functional relationship between the printed matter (message) and the substrate (note) which carries it. In regard to claim 2, the feeling of love is identified in the note of Ledman et al. In regard to claims 3 and 7, it is considered obvious to place any message as desired on the note, i.e. the particular indicia placed onto the note is not considered to be a patentable feature. In regard to claims 4 and 9, Ledman et al. does not disclose placing wrapping paper around the package. Kough shows in figure 10 the idea of placing wrapping paper (42) around a package (44). In view of the teachings of Kough it would have been obvious to one in the art to modify Ledman et al. by placing wrapping paper around the package since this would allow the package to be given to a recipient as a gift in a more aesthetically pleasing and surprising manner. In regard to claim 6, Ledman et al. shows in figure 1 that the package is a closed package. In regard to claim 8, as broadly defined, the package of Ledman et al. is considered to be a "gift-style container". In regard to claim 10, as broadly defined, the package of Ledman et al. is considered to be envelope since it is something that envelops, see Webster's II New Riverside Dictionary which defines envelope as something that envelops.

Applicant's arguments filed Nov. 19, 2004 have been fully considered but they are not persuasive.

The applicant argues that the examiner has failed to establish that there is a suggestion or motivation to modify Ledman et al., as proposed. Specifically, Applicant's independent claim 1 requires "placing a note on the package", and independent claim 5 contains a similar limitation. Conversely, Ledman, et al., teaches carving the message into the box itself, or placing it within

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the box. The applicant asserts that this teaching of Ledman, et al., to insert the message within the box teaches away from the limitation of placing a note on the package so that the package may remain unopened. The examiner disagrees since Ledman, et al. shows in figures 1 and 2 a note (15) which contains a message thereon. Ledman, et al. does not disclose whether the note (15) is placed on the package. The Kough patent is being used by the examiner to show that it is known to place a note (60) onto a package, see figure 10 of Kough. Attaching the note (15) to the package offers the advantage of making it clear that the note belongs with the package, helping to prevent the note and package from being separated, and allowing the message on the note to be clearly seen. The applicant appears to believe that the examiner is calling the letters (33 or 35) in Ledman et al. as the note but this is incorrect. As discussed above, the note (15) shown in figures 1 and 2 in Ledman, et al. is considered to be the "note".

The applicant argues that Ledman, et al. in view of Kough fail to show the limitation that the note include "a request that the package remain unopened but suggesting that the unopened package is filled with the positive feelings". The applicant argues that the step of having a "request that the package remain unopened but suggesting that the unopened package is filled with the positive feeling" is an essential feature of the present invention not shown in either piece of prior art. Ledman, et al. in view of Kough disclose all of the structure defined by the applicant in the claims except for the particular message on the note. Ledman, et al. discloses that the note (15) include a message thereon, see figures 1 and 2. The only difference between the applicant's note and the Ledman, et al. note (15) is the specific words placed on the note. Printed matter that is not functionally related to the substrate does not distinguish the invention from the prior art, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). In the applicant's case, there

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is no functional relationship between the printed matter (message) and the substrate (note) which carries it.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
Jan. 26, 2005